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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,623	03/24/2004	Kevin David Galloway	END920030164US1	8921
<div>7590 Chad M. Herring, Esq. 8501 N. MoPac Exwy. Suite 310 Austin, TX 78759</div>			<div>EXAMINER NGUYEN, PHILLIP H</div>	
			<div>ART UNIT 2191</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 06/22/2007</div>	<div>DELIVERY MODE PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/807,623	Applicant(s) GALLOWAY ET AL.	
	Examiner Phillip H. Nguyen	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20040324</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is response to the original filing date of 3/24/2003. Claims 1-46 are pending and have been considered below.

#### ***Information Disclosure Statement***

2. The second page of the Information Disclosure Statement filed on 3/24/2004 is missing and only the first page has been considered. Applicant is required to submit the second page of the Information Disclosure Statement.

#### ***Examiner Note***

3. Applicant appears to be attempted to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph in claims 24, 28, 30-36, 40 and 42-46 by using "means plus function" language. However, Examiner notes that the only "means" for performing these cited functions in the specification appears to be software (computer-readable program). Since no other specific structural limitations are disclosed in the specification, the claims have not invoked 35 U.S.C. 112 6<sup>th</sup> paragraph. Additional item to consider also is that even the "means" are referred to hardware components, the claims also recite sufficient structure, which is "computer-readable program" for performing those cited functions. While the claims pass the first of the three-prong test used to determine invocation of paragraph 6<sup>th</sup>, since it also recites sufficient structure within the claims themselves to perform entirely recited functions, the claims are not in means plus function format,

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even if the claims use the term "means." Therefore, 35 U.S.C. 112 6<sup>th</sup> paragraph has not been invoked when considering these claims below.

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 24-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 24-46 recite "a computer-readable program product, which is directed to software per se, lacking of storage on a computer-readable medium, which enables any underlying functionality to occur. Therefore, claims 24-46 are non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Strothmann (United States Patent No.: 5,745,880).

As per claims 1 and 24:

Strothmann discloses:

- receiving identifications of respective migration tasks (see at least col. 2, lines 44-45 "**move or migrating**");
- correlating base costs to respective ones of said migration tasks (see at least col. 4, line 67 – col. 5, lines 1-2 "**if migration of an application which comprises 10% of the total cost base is being considered, then 100 generic units are being moved.**");

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- receiving identifications of migration attributes that affect migration cost (see at least (see at least col. 2, lines 59-61 “**three broad categories are identified hardware and software costs...**”);
- correlating cost factors to respective ones of said migration tasks, each of said cost factors indicating an amount by which a migration attribute affects the base cost of a migration task (see at least “**TABLE C and TABLE D**”, also see at least FIGS. 2A-2C); and
- estimating a cost for each migration task, by applying the cost factors for each migration task to the base cost of the migration task (see at least “**TABLE D**”, also see at least FIGS. 2A-2C).

As per claims 2 and 25:

Strothmann discloses:

- wherein migration tasks comprise one or more tasks chosen from a group consisting of system building, project management, ramp up, baseline testing, migration, system testing, delivery, acceptance testing, sign-off, exporting data, importing data, redirecting user terminals, replacing third party products, and deployment (see at least col. 2, lines 44-45 “**move or migrating**”, also see col. 8, line 55-59 “**Data Synchronization**”).

As per claims 3 and 26:

Strothmann discloses:

- wherein migration attributes comprise one or more attributes chosen from a group consisting of hardware attributes, operating system attributes, application attributes, environment attributes, source code attributes, complexity attributes, and testing attributes (see at least col. 2, lines 59-61 **“three broad categories are identified hardware and software costs...”**).

As per claims 4 and 27:

Strothmann discloses:

- wherein source code attributes comprise at least one code metric chosen from a group consisting of number of code lines, number of code modules, number of files, call types, number of calls, data volume, structural integrity, use of lexical functions, and operating system dependence (see at least col. 5, line 39 **“migration of an application or applications...”**).

As per claims 5 and 28:

Strothmann discloses:

- estimating a total cost, by summing the estimated costs of all migration tasks (see at least col. 5, lines 41-43 **“the total projected conversion costs are two hundred fifty thousand dollars (\$250,000)...”**); and
- displaying or printing a migration assessment comprising the total cost (see at least **“TABLE D”**).

As per claims 6 and 29:

Strothmann discloses:

- wherein the migration assessment further comprises the estimated cost for each migration task (see at least col. 5, line 45 "**Table D shows the conversion costs per generic unit**").

As per claims 7 and 30:

Strothmann discloses:

- applying tolerances to one or more of the estimated costs and total cost (see FIGS. 2A-2C); and
- wherein one or more of the estimated costs and total cost comprises a cost range (see at least "**TABLE D**").

As per claims 8 and 31:

Strothmann discloses:

- wherein one or more of the base costs are received from a user (see at least col. 5, line 1 "**10% of the total cast base is being considered...**").

As per claims 9 and 32:

Strothmann discloses:

- wherein one or more of the cost factors are received from a user (see at least "**TABLE C and TABLE D**").



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As per claims 10 and 33:

Strothmenn discloses:

- receiving at least one assessment type, each assessment type comprising a degree of accuracy for one or more of the estimated costs and total cost (see at least **"TABLE D"** – shows the conversion costs for each assessment type).

As per claims 11 and 34:

Strothmann discloses:

- creating an assessment template, the assessment template comprising a format for the migration assessment (see at least **"TABLE P"**).

As per claims 12 and 35:

Strothmann discloses:

- correlating base time requirements to respective ones of said migration tasks (see at least **"TABLE O"**);
- correlating time factors to respective ones of said migration tasks, each time factor indicating an amount by which a migration attribute changes the base time requirement for a migration task (see at least **"TABLE O"** and **"TABLE P"**); and
- estimating a time requirement for each migration task, by applying all time factors for the migration task to the base time requirement for the migration task (see at least **"TABLE O"**, also see FIGS. 2A-2C).

As per claims 13 and 36:

Strothmann discloses:

- receiving identifications for respective migration tasks (see at least col. 2, lines 44-45 **"move or migrating"**);
- correlating base time requirements to respective ones of said migration tasks (see at least col. 8, **"TABLE O"**);
- receiving identifications of migration attributes that affect migration time (see at least col. 2, lines 59-61 **"three broad categories are identified hardware and software costs..."**);
- correlating time factors to respective ones of said migration tasks, each time factor indicating an amount by which a migration attribute changes the base time requirement for a migration task (see at least col. 8, **"TABLE O"** and **"TABLE P"**); and
- estimating a time requirement for each migration task, by applying all time factors for the migration task to the base time requirement of the migration task (see at least col. 8, **"TABLE O"**, also see FIGS. 2A-2C).

As per claims 14 and 37:

Strothmann discloses:

- wherein migration tasks comprise one or more tasks chosen from a group consisting of system building, project management, ramp up, baseline testing, migration, system testing, delivery, acceptance testing, sign-off, exporting data,

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importing data, redirecting user terminals, replacing third party products, and deployment (see at least col. 2, lines 44-45 "**move or migrating**", also see at least col. 8, line 55-59 "**Data Synchronization**").

As per claims 15 and 38:

Strothmann discloses:

- wherein migration attributes comprise one or more attributes chosen from a group consisting of hardware attributes, operating system attributes, application attributes, environment attributes, source code attributes, complexity attributes, and testing attributes (see at least col. 2, lines 59-61 "**three broad categories are identified hardware and software costs...**").

As per claims 16 and 39:

Strothmann discloses:

- wherein source code attributes comprise at least one code metric chosen from a group consisting of number of code lines, number of code modules, number of files, call types, number of calls, data volume, structural integrity, use of lexical functions, and operating system dependence (see at least col. 5, line 39 "**migration of an application or applications...**").

As per claims 17 and 40:

Strothmann discloses:

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- estimating a total time requirement, by summing the time requirements for all migration tasks (see at least col. 8, "**TABLE O**"); and
- printing or displaying a migration assessment comprising the total time requirement (see at least col. 8, "**TABLE O**").

As per claims 18 and 41:

Strothmann discloses:

- wherein the migration assessment further comprises the estimated time requirement for each migration task (see at least col. 8, "**TABLE O**").

As per claims 19 and 42:

Strothmann discloses:

- applying tolerances to one or more of the estimated time requirements and total time requirement; and wherein one or more of the estimated time requirements and total time requirement comprises a cost range (see at least col. 8, "**TABLE O**" and "**TABLE P**").

As per claims 20 and 43:

Strothmann discloses:

- wherein one or more of the base time requirements are received from a user (see at least col. 8, "**TABLE O**").

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As per claims 21 and 44:

Strothmann discloses:

- wherein one or more of the time factors are received from a user (see at least col. 8, **"TABLE O"**).

As per claims 22 and 45:

Strothmann discloses:

- receiving at least one assessment type, each assessment type comprising a degree of accuracy for one or more of the estimated time requirements and total time requirement (see at least col. 8, **"TABLE O" – shows the conversion period for each assessment type**).

As per claims 23 and 46:

Strothmann discloses:

- creating an assessment template, the assessment template comprising a format for the migration assessment (see at least col. 8, **"TABLE P"**).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ruffin et al. (United States Patent No.: US 6,260,020 B1), discloses method, system and program product for sizing a computer system migration programming effort.
- Srinivasan et al. (United States Patent No.: US 6,895,382 B1), discloses method for arriving at an optimal decision to migrate the development, conversion, support and maintenance of software applications to off shore/off site locations.
- Ruffin et al. (United States Patent No.: US 6,968,324 B1), discloses method, system and program product for evaluating a computational processing capacity migration between computer platforms.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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